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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,093	02/26/2002	Jeffrey J. Shea	10557/266546	5422
30559	7590	06/04/2003		
CHIEF PATENT COUNSEL SMITH & NEPHEW, INC. 1450 BROOKS ROAD MEMPHIS, TN 38116			EXAMINER	
			RAMANA, ANURADHA	
		ART UNIT	PAPER NUMBER	
		3732		
DATE MAILED: 06/04/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

N.K

Office Action Summary	Application No.	Applicant(s)
	10/083,093	SHEA ET AL.
	Examiner Anu Ramana	Art Unit 3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 26 February 2002.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-38 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 26 February 2002 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4 and 5</u> . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Drawings

Figures 1A, 1B, 1C, 2A and 2B should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 14 recites the limitation "first surface" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Williamson et al. (US 5,925,077).

Williamson et al. disclose an implantable prosthesis 10 with a prosthetic or acetabular shell component 88 having first and second surfaces; (ii) an opening or aperture 90 extending from the first surface to the second surface wherein the aperture wall is tapered to form a

frustoconical tapered section; and (iii) a plug or an “insertion member” or “an aperture cover” 98 with a spherical or near-spherical head 104 that mates with aperture wall for a fluid-tight seal (col. 6, lines 35-51 and Figures 11A and 11B).

Regarding claims 25-26, Williamson discloses the implantable or acetabular prosthesis, used in total hip arthroplasty, as having a bearing member or liner 14 which provides an articulation surface for ball 180 of a femoral component 182 (col. 1, lines 7-12, col. 2, lines 41-48 and col. 9, lines 21-24).).

The method steps of claims 27-38 are inherently performed during normal use of the Williamson et al. prosthesis for total hip arthroplasty.

Claims 1-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Khalili (US 6,228,121).

Regarding claims 1-10, 11-12, 13-18 and 19-24, Khalili discloses (i) an implantable prosthesis 100 with a prosthetic component 102 having first and second surfaces; (ii) an opening or aperture 106 extending from the first surface to the second surface wherein the aperture wall 114 is tapered such that the inner most end 118 of the aperture is larger than the outermost end (frustoconical tapered section); and (iii) an insertion member or screw 108 with a spherical or near-spherical head 126 that mates with aperture wall 114 for a fluid-tight seal (col. 3, lines 28-33 and lines 61-67 and col. 4, lines 1-31).

Regarding claims 25-26, Khalili discloses the implantable or acetabular prosthesis, used in total hip arthroplasty, as having a bearing member or liner 104 which provides an articulation surface for ball 18 of a femoral component 20 (col. 1, lines 19-45 and Figure 1).

The method steps of claims 27-38 are inherently performed during normal use of the Khalili prosthesis for total hip arthroplasty.

Claims 1-4, 7, 9-12, 19-22 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Kondo (US 3,779,240).

Kondo discloses an implantable prosthesis 21 having an opening 46 with an extended frustoconical taper section and an insertion member or screw 43 inserted into opening 46 such

that screw 46 is locked relative to the frustoconical taper section (Figures 8 and 9, col. 3, lines 5-11 and lines 51-66 and col. 4, lines 1-18).

Claims 1-7, 10-12 and 19-21 and 23-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Wolter (US 6,322,562).

Wolter discloses an implantable prosthesis or bone plate 10 having passage holes 9 with an extended frustoconical taper section into which screws or insertion members 1 with a spherical seat surface or head 4 are placed for securing the bone plate 10 to bone (col. 6, lines 22-32 and lines 43-46, col. 7, lines 10-28 and Figure 2c).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolter.

Although Wolter does not disclose a fluid-tight seal between insertion member 1 and passage hole 9, it would have been an obvious matter of design choice to change the size of the passage hole 9 so that the spherical head 4 of insertion member 1 creates a fluid-tight seal, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicants' attention is specifically directed to Schryver et al. (US 5,310,408): Figure 20.

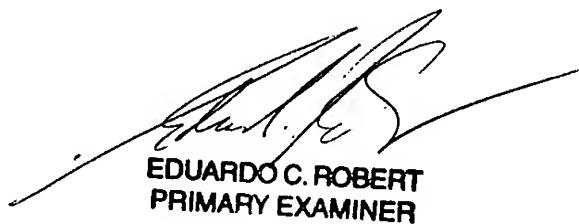
Art Unit: 3732

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (703) 306-4035. The examiner can normally be reached Monday through Friday between 8:30 am and 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached at (703) 308-2582. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-2708 for regular communications and (703) 308-2708 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

AR *Anuradha Ramana*
June 2, 2003



EDUARDO C. ROBERT
PRIMARY EXAMINER